UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,050	01/24/2007	Jean-Luc Collet	FR920030070US1	1186

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HOFFMAN WARNICK LLC
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EXAMINER
CHANG, LI WU

ART UNIT	PAPER NUMBER
2129	

NOTIFICATION DATE	DELIVERY MODE
03/04/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *27 January 2009*.

2a) ☐ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3,4,6-8,10 and 11* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,3,4,6-8,10 and 11* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some *   c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This office action is responsive to the amendment (Special Amended) filed

01/27/2009 with priority date 11/27/2003. Claims 2, 5 and 9 are cancelled. Claims 1, 3-

4, 8, 10-11 are currently amended. Claims 1, 3-4, 6-8 and 10-11 are pending.

Response to Amendment

Applicant's arguments with respect to claims 1, 3-4, 6-8 and 10-11 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 1, 3-4, 6-8 and 10-11 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter. Regarding claim 1, it is

directed a system comprising modules. The specification does not specify a module as

a hardware device. Therefore, claim 1 reads on non-statutory material such as software

per se. As to Claim 4, it is directed to a method comprising steps. The court has said

that there's a two-pronged test to determine whether a software of business method

process patent is valid: (1) it is tied to a particular machine or apparatus, or (2) it

transforms a particular article into a different state or thing. In other words, pure

software or business method patents that are neither tied to a specific machine nor

change something into a different state are not patentable. Ex parte Bilski, Appeal No.

2007-1130 (Fed. Cir. October 30, 2008). Each step in claim 4 can only be software.

Accordingly, claim 4 that is directed to software that is not embodied on a computer

readable storage medium is not statutory. As to claims 8 and 14, they are again directed

to a system comprising modules that are not hardware devices. Accordingly, claims 8

and 14 are not statutory. As to any claim not specifically discussed it is a dependent

claim that is rejected for the reasons given above with respect to the claim(s) on which it

depends.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 3-4, 8, 10-11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ishiguri (US 2002/0004837 A1), hereinafter **Ishiguri**, in view of

Christenson (US 7117246 B2), and hereinafter **Christenson**.

4.   With respect to claim 1, Ishiguri discloses system for enhancing security of e-

mails transmitted from a sender to a receiver over a data transmission network,

comprising:

a Message Transfer Agent (MTA) e-mail transfer apparatus associated with said sender

for transmitting over said network an original e-mail sent by said sender (**Ishiguri**:

[0005] "e-mail transfer apparatus" or [0011], "an e-mail communication apparatus")

said MTA e-mail transfer apparatus associated with said sender including a message

splitting means adapted to divide said original e-mail into a plurality of chunks according

to a predetermined algorithm and a predetermined list of relay MTAs a communication

channel to which are forwarded said plurality of chunks (**Ishiguri**: [0011], "division

control means for dividing transmission data into divisional data based on a

predetermined data amount" implies splitting e-mail into chucks according to a

predetermined algorithm, "transmitting means for transmitting the divisional data

produced by the division control means" implies forwarding to receiver devices plurality

of chunks "via the communication channel" [0047]); and

a chunk assembly agent for receiving from said relay MTAs a communication channel

the plurality of chunks and for re-assembling the plurality of chunks using said

predetermined algorithm in order to re-build said e-mail before sending it to said

receiver (**Ishiguri**: [0011], "receiving means for receiving data; and recombination

control means for recombining the data received by the receiving means when the data

are divisional data" implies re-build said e-mail before sending it to said receiver,

wherein "the reception control section", as in Fig 5 or [0047], is an example of a chunk

assembly agent),

wherein each of said plurality of chunks is transmitted as a chunk e-mail having a same

destination e-mail address, the destination e-mail address comprising an e-mail address

of the chunk assembly agent (**Ishiguri**: [0005], "a transmission destination address",

[0044], "the transmission control section 4 adds a header including a transmission

destination" "according to the ordinary e-mail transmission procedure" or Fig 5, implies

divisional data, i.e., chunks, are transmitted to the same destination e-mail address, and

destination e-mail address comprising the –mail address of the "reception control

section" i.e., a chunk assembly agent).

Ishiguri does not particularly call for "MTA" and "a predetermined list of relay MTAs ".

Christenson discloses "MTA" and "a predetermined list of relay MTAs " (**Christenson**:,

C 2, L 25-30, "Relays mail to another MTA"). It would have been obvious for one of

ordinary skill in the art at the time of invention to incorporate conventional terms, such

as "MTA" and "relay MTA", into the e-mail communication framework of Ishiguri

because the e-mail transmission and receiving apparatus of Ishiguri possess the

functions of MTA.

5.   With respect to claim 4, the claim is substantially the same as claim 1 and

therefore, it is rejected for the same reason as in claim 1 above.

6.   With respect to claim 8, the claim is substantially the same as claim 1 and

therefore, it is rejected for the same reason as in claim 1 above.

7.   With respect to claim 11, the claim is substantially the same as claim 1 and therefore, it is rejected for the same reason as in claim 1 above.

8.   Claims 3, 6-7, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiguri**, in view of **Christenson**, as applied to claims 1, 4 and 8 above, further in view of Grobman et al. et al. (US 20040190722 A1), and hereinafter **Grobman.**

9.   With respect to claims 3, 6 and 11, Ishiguri discloses wherein each of said plurality of chunks is encrypted before being transmitted over said network (**Christenson**: C 6, L 30-40, MD5 algorithm, where it is used before transmission). The combined teachings of Ishiguri and Christenson do not particularly call for "encrypted using a public key of said chunk assembly agent". Grobman discloses "encrypted using a public key of said chunk assembly agent" (**Grobman**: [0019], L 2-7 and L 13-18, or [0020], L 1-5, wherein a chunk or an e-mail is encrypted with a public key of a user or a manager, [0032], i.e., a chunk assembly agent). It would have been obvious for one of ordinary skill in the art at the time of invention to incorporate the public key encryption, as taught by Grobman, into the e-mail communication framework of Ishiguri because the public key encryption may provide strong security for e-mail message and transmission, a desirable feature of Ishiguri.

10.   With respect to claim 7, Ishiguri discloses wherein text of said original e-mail is encrypted before being divided into a plurality of chunks (**Christenson**: C 6, L 30-40,

MD5 algorithm, where it is used before transmission). Grobman discloses encryption

with the public key of the receiver (**Grobman**: [0019], lines 3-5 and lines 15-16).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to LIWU CHANG whose telephone number is 571-270-

3809. The examiner can normally be reached on 8:30AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Vincent can be reached on 571-272-3080. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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LIWU CHANG
Examiner
Art Unit 2129

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2/20/09
/David R Vincent/
Supervisory Patent Examiner, Art Unit 2129